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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,877	10/18/2001	Anthony E. Martinez	AUS920010923US1	7079
70748	7590	11/25/2008		
IBM Corp. (RCR) c/o Rolnik & Associates, P.C. 24 N. Main St. Kingwood, TX 77339			EXAMINER BONSHOCK, DENNIS G	
			ART UNIT 2173	PAPER NUMBER
			MAIL DATE 11/25/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/981,877	<b>Applicant(s)</b> MARTINEZ ET AL.	
	<b>Examiner</b> DENNIS G. BONSHOCK	<b>Art Unit</b> 2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8-6-08.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6-27-08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

***Final Rejection***

***Response to Amendment***

It is hereby acknowledged that the following papers have been received and placed on record in the file: Amendment as received on 8-6-2008.

Claims 1-17 have been examined.

Status of Claims:

Claims 1-3 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft, "Microsoft Word," hereinafter MSword in view of Foster et al., Patent Number: 5,404,442, hereinafter Foster.

Claim 17 is rejected under 35 U.S.C. 102(a) as being anticipated by Microsoft, "Microsoft Word," hereinafter MSword.

Claims 4-8 and 12-16 have been withdrawn.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claim 17 is rejected under 35 U.S.C. 102(a) as being anticipated by Microsoft, "Microsoft Word," hereinafter MSword.

3. With regard to claim 17, which teaches a method of displaying a clipboard comprising: receiving a paste command, MSword teaches, in figure 2 and 4, receiving

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a paste command through an icon on the clipboard, through the Edit menu, or through typing CONTROL+V on the keypad. With regard to claim 17, which further teaches determining whether a plurality of objects are stored within the clipboard in response to the paste command, MSword teaches, in figures 2, 4, and 10, that in order for an item to be pasted it must be copied/cut from a document first, and upon a selection of more than one item to be copied/cut the clipboard is automatically displayed on the screen. With regard to claim 17, further teaching displaying a clipboard adjacent a display position indicator, if it is determined a plurality of objects are within the clipboard, MSword teaches, in figures 1 and 2 that upon selection of more than one item to be stored on a clipboard the clipboard is displayed to provide the user with a selectable array of pasteable items. With regard to claim 17, which further teaches removing the clipboard in response to moving the position indicator so that the position indicator is not adjacent to the clipboard, MSword teaches, in figures 6 and 7, hiding the clipboard upon position the indicator off of the clipboard and onto the document.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 1-3 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft, "Microsoft Word," hereinafter MSword in view of Foster et al., Patent Number: 5,404,442, hereinafter Foster.

11. With regard to claim 1, which teaches a method of previewing a graphical image corresponding to an icon in a clipboard (see MS figure 2), comprising: receiving a icon preview instruction from a user, MSword teaches, in MS figure 2, the user accessing a preview of a clipboard item through a mouse over event. With regard to claim 1, further teaching displaying the graphical image associated with the icon in response to the icon preview instruction, MSword teaches, in MS figure 2, the system displaying a preview (text representative of text copied to the clipboard element) of a clipboard item in response to a mouse over event.

MSword, however, doesn't specifically teach displaying a **graphical image** associated with the icon in response to the icon preview instruction (see board decision of 1-4-2008).

Foster teaches a process for copying items to a display space (clipboard) for later use in insertion into a document (see column 7, line 56 through column 8, line 15 and in figures 4e-4f), similar to that of MSword, but further teaches, in the second process, that upon a user selection of an item from the group of clipped items the user is provided with a visual depiction of the actual object the pointer is positioned over (see column 9, lines 44-65 and figure 5c) where elements available for clip based storage include both text elements and graphic elements (see column 7, line 56 through column 8, line 15 and in figures 4e-4f). Foster further teaches the ability for clipboard icons to

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indicate the actual content of the clipboard object, showing a miniature version of the actual graphical object (see column 12, lines 18-23).

It would have been obvious to one of ordinary skill in the art, having the teachings of MSword and Foster before them at the time the invention was made to modify text based representation of the contents of a clipped item of MSword to include a graphical representation of the actual object being dragged. One would have been motivated to make such a combination so as to allow the user to “see the object and therefore more accurately position the object for pasting into the application program” (see Foster column 9, lines 63-65).

12. With regard to claims 2 and 10, which teach receiving an icon preview instruction comprises determining whether a display position indicator is positioned over the icon displayed in the clipboard for a predetermined time period, MSword teaches, in MS figures 2 and 3, the preview being delayed by some predetermined time.

13. With regard to claims 3 and 11, which teach displaying the graphical image comprises displaying a reduced image of the graphical image, MSword teaches, in MS figures 2 and 9, upon positioning an indicator over an element in the clipboard, displaying a subset of the text copied to the clipboard. Foster further teaches, initiating selection of an item from the group of clipped items causing the user to be provided with a visual depiction of the actual object the pointer is positioned over (see column 9, lines 44-65 and figure 5c) where elements available for clip based storage include both text elements and graphic elements (see column 7, line 56 through column 8, line 15 and in figures 4e-4f). Foster further teaches the ability for clipboard icons to indicate the actual

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content of the clipboard object, showing a miniature version of the actual graphical object (see column 12, lines 18-23).

14. With regard to claim 9, which teaches a computer usable medium including a program for previewing a graphical image corresponding to an icon in a clipboard (see MS figure 2), comprising: computer readable code for receiving a icon preview instruction from a user, MSword teaches, in MS figure 2, the user accessing a preview of a clipboard item through a mouse over event. With regard to claim 9, further teaching computer readable code for displaying the graphical image associated with the icon in response to the icon preview instruction, MSword teaches, in MS figure 2, the system displaying a textual preview of a clipboard item in response to a mouse over event.

MSword, however, doesn't specifically teach displaying a **graphical image** associated with the icon in response to the icon preview instruction (see board decision of 1-4-2008).

Foster teaches a process for copying items to a display space (clipboard) for later use in insertion into a document (see column 7, line 56 through column 8, line 15 and in figures 4e-4f), similar to that of MSword, but further teaches, in the second process, that upon a user selection of an item from the group of clipped items the user is provided with a visual depiction of the actual object the pointer is positioned over (see column 9, lines 44-65 and figure 5c) where elements available for clip based storage include both text elements and graphic elements (see column 7, line 56 through column 8, line 15 and in figures 4e-4f). Foster further teaches the ability for clipboard icons to indicate the actual content of the clipboard object, showing a miniature version of the

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actual graphical object (see column 12, lines 18-23). It would have been obvious to one of ordinary skill in the art, having the teachings of MSword and Foster before him at the time the invention was made to modify text based representation of the contents of a clipped item of MSword to include a graphical representation of the actual object being dragged. One would have been motivated to make such a combination so as to allow the user to “see the object and therefore more accurately position the object for pasting into the application program” (see Foster column 9, lines 63-65).

### ***Response to Arguments***

The arguments filed on 6-27-2008 have been fully considered but they are not persuasive. Reasons set forth below.

The Applicant argues that the figures clearly show an icon remains present through the dragging path of the stylus.

In response, the Examiner respectfully submits that Foster teaches, in column 9, lines 44-51, alternately converting the visible clipboard icon into the objet that it is carrying.

The Applicant argues that there is nothing in Foster that can be considered a preview or response to an icon preview instruction in the manner claimed.

In response, the Examiner respectfully submits that Foster teaches converting the visible clipboard icon into the objet that it is carrying so that it can be dragged and placed into an application program (see column 9, lines 44-51 and figure 5c).



The Applicant argues that one of ordinary skill in the art would not have been motivated to combine MSword with Foster.

In response, the Examiner respectfully submits that both references analogously transform the representation of the icon upon user initiation of selection to paste (see MS Figure 2 and Foster column 9, lines 44-51 and figure 5c).

The Applicant argues "How can foster display an image in response to an icon preview instruction, if the image is already present on the Foster icon?"

In response, the Examiner respectfully submits that when docked a default generic image is displayed to the user, only under user initiation of a drag operation is it converted in to the object it carries (see column 9, lines 44-51 and figure 5c).

The Applicant argues that the references don't teach "the displaying step is in response to the icon preview instruction".

In response, the Examiner respectfully submits that both references analogously transform the representation of the icon upon user initiation of selection to paste (icon preview instruction) (see MS Figure 2 and Foster column 9, lines 44-51 and figure 5c).

The Applicant argues that the references don't teach "computer readable code".

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In response, the Examiner respectfully submits that Microsoft's Word is well known in the art as a computer program (computer readable code) that causes a display of information on a display. Foster additionally teach a CPU processing data under control of the OS to produce appropriate images on the display (see column 5, lines 52-57).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to DENNIS G. BONSHOCK whose telephone number is (571)272-4047. The examiner can normally be reached on Monday - Friday, 6:30 a.m. - 4:00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Chow can be reached on (571) 272-7767. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis G. Bonshock/  
Primary Examiner, Art Unit 2173  
11-4-08  
dgb

<b>Application Number</b> 	<b>Application/Control No.</b> 09/981,877	<b>Applicant(s)/Patent under Reexamination</b> MARTINEZ ET AL.	
	<b>Examiner</b> DENNIS G. BONSHOCK	<b>Art Unit</b> 2173	